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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/084,266

02/25/2002

Shoji Nakajima

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04/18/2006

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EXAMINER

LONEY, DONALD J

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,266

Applicant(s)

NAKAJIMA ET AL.

Examiner

Donald Loney

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 56-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's discussion of the prior art in view any of Frohlich (2033066), Larmour (2237152) or Poll (5338591).

In the applicants discussion of the prior art (figures 3, prior art 1, and 4, prior art 2) it is discussed that it is know to attach a second member 11, made of glass, to a first member 13 or 203, made of cloth or leather, using a hot-melt 12. The two prior art structures either attach the second member to a side of the first member which is flat (figure 3) or attach the second member with a through hole to the first member (figure 4). The applicants' invention is in inlaying (i.e. impressing) the second member in the first member (i.e. it is attached as per the various portions recited and explained as equating to an inlaid structure above). The prior art also shows the water-proof coating 202 applied to the leather substrate.

All of the secondary references disclose embedding (inlaid) decorative elements in a fabric and/or leather in order to form a strong bond which minimizes the any chances of the inlaid being accidentally removed. Frohlich teaches a first leather member 10 containing an inlaid (i.e. embedded) second member 16 using a hot-melt 12. Larmour teaches to inlay a member 4 (i.e. inlaid metal piece) using a hot-melt in a substrate 2 in order to form a strong bond which minimizes the any chances of the inlaid being accidentally removed. Refer to column 2, lines 50-61. Poll teaches to improve the mounting of gems (i.e. glass pieces) by impressing the gem into a fabric substrate, versus the prior arts mounting the gem on a flat substrate. This is the prior art the applicant is discussing in figure 3. Refer to figure 1 showing gem 5 inlaid in fabric

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substrate 3 along with column 1, lines 14-24, column 3, lines 19-65. The layers 2 and/or 4 used to attach the gem are not specifically disclosed as a hot-melt, but are disclosed as having adhesive properties.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the prior art to inlay the glass pieces into the leather or fabric, as taught by the secondary references, motivated by the fact the secondary references teach to inlay the gems, versus to just attach them to a flat layer, for the purpose of providing improved adhesion of the gem to the substrate. Regarding the size of the gem, refer to column 3, lines 44-46 in Poll. Also, it would be obvious to form them of what ever size in order to provide the desired decorative effect. With regards to the increased density located (i.e. also equating to the thinner section in claim 60) below the impressed gem, it is inherent if one impresses some thing into a fibrous substrate the density is increased at that point. The examiner cites the reference to Wheeler (4913639) for a teaching to the fact. Refer to compressed region 52 therein along with column 4, line 66 through column 5, line 2. With regards to the waterproofing layer being under the inlay (claims 56 and 60), this would be the case when prior art 2 (i.e. figure 4) has the inlay only embedded in the substrate since (i.e. the combination of the references) it is on the substrate before embedding takes place. Also the coating would be partially transmuted per claim 60 due to the pressing nature of inlaying the gem. With regards to claims 59 and 63 that the waterproof coating contacting side portions of the

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Insert figure 3 in Frohlich shows the top protective coating 18 touching side surfaces of the insert. Also, as in prior art 2 as referred to above the coating would touch the side of the insert when only partially embedded as explained.

Response to Arguments

5. Applicant's arguments with respect to claims 56-65 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-

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1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald Loney
Primary Examiner
Art Unit 1772

DJL;D.Loney
04/13/06